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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,366	12/01/2003	Iwao Saikatsu	032126	8101

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EXAMINER

RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/724,366	Applicant(s) SAIKATSU ET AL.	
	Examiner Vickey Ronesi	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/1/2003</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 12/04/2002. It is noted, however, that applicant has not filed a certified copy of JP 2002-351988 application as required by 35 U.S.C. 119(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Brewer (US 5,856,278).

Brewer discloses a friction material comprising 5-80 vol. % abrasive such as alumina having a particle size of 1-10 microns; 5-40 vol. % cured organic resin/rubber (e.g., nitrile rubber) binder; and a fibrous base (col. 1, lines 37-50). Note Examples 1 and 2 in col. 2 where solvated NBR (i.e., the unvulcanized rubber of the binder) is present in an amount of 15 vol. %. While the binder is cured, it is not vulcanized and therefore the solvated NBR reads on the instant claims.

Although Brewer discloses the unvulcanized rubber as part of the binder component and the presently claimed invention has the unvulcanized rubber as part of the filler (C) component, it is the examiner's position that once the ingredients are mixed together to form the friction

Art Unit: 1714

material, the distinction between the components becomes unnecessary since the final product is the same regardless of the description of the components before mixing.

With respect to the Mohs hardness value in present claim 2, given that the alumina of Brewer is also utilized by the present invention and a material and its properties are inseparable, it is inherent that the alumina of Brewer have a Mohs hardness of 6 or more.

In light of the above, it is clear that Brewer anticipates the presently cited claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara et al (US 6,220,404) in view of Tabe et al (US 4,324,706).

Hara et al discloses a friction material comprising a fibrous base (col. 4, lines 14-24), a binder (col. 3, lines 37-47; col. 4, lines 25-29), and 20-70 vol. % friction adjusting agents wherein 0.5-20 vol. % of the friction is a zeolite having an average particle size of 1-10 microns and up to 70 vol. % other friction adjusting agents such as acrylic rubber, isoprene rubber, NBR, and SBR (col. 4, lines 9-61). See Table 2 in col. 5 for exemplified amounts in vol. %.

Hara et al does not disclose whether the rubber friction adjusting agents are unvulcanized or vulcanized.

Art Unit: 1714

Tabe et al discloses a friction material and teaches that friction regulating (i.e., adjusting) agents include both vulcanized and unvulcanized rubbers (col. 9, lines 48-51).

While Hara et al does not disclose whether or not its friction adjusting agents are unvulcanized, given that Tabe et al teaches that unvulcanized rubbers are known to perform as friction adjusting agents in friction materials, it would have been obvious to one of ordinary skill in the art to utilize unvulcanized friction adjusting agents and thereby arrive at the presently cited claims.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hara et al (US 6,220,404) in view of Tabe et al (US 4,324,706) and further in view of Sakamoto et al (US 5,006,589).

The discussion with respect to Hara et al and Tabe et al in paragraph 3 above is incorporated here by reference.

Hara et al does not teach the Mohs hardness of the zeolite.

Sakamoto et al discloses that zeolite is included with inorganic particles which have a Mohs hardness of 6 or above (col. 3, lines 47-55).

Given that zeolite has a Mohs hardness of at least 6 as taught by Sakamoto et al, it would have been obvious to one of ordinary skill in the art to utilize a filler such as zeolite with the presently claimed Mohs hardness.

Art Unit: 1714

Contact Information

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

8/4/2005

vr



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